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10/065,736	11/13/2002	Chi-Lei Kao	10053USPA-0C	6177

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JIANQ CHYUN INTELLECTUAL PROPERTY OFFICE  
7 FLOOR-1, NO. 100  
ROOSEVELT ROAD, SECTION 2  
TAIPEI, 100  
TAIWAN

EXAMINER

LEVI, DAMEONE

ART UNIT

PAPER NUMBER

2841

DATE MAILED: 12/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/065,736

Applicant(s)

KAO, CHI-LEI

Examiner

Dameon E Levi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 13 November 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-6,8-17,19-21 and 27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6,8-17,19-21 and 27 is/are rejected.
- 7) ☒ Claim(s) 5,12,13,14,15,16,19,20,27 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 November 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☒ Certified copies of the priority documents have been received in Application No. 10/065,563.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Claim Objections***

The claims are objected to because they include reference characters, which are not enclosed within parentheses (See "A", "B", "C" claims 5,12,13,14,15,16,19,20,27)

Reference characters corresponding to elements recited in the detailed description of the drawings and used in conjunction with the recitation of the same element or group of elements in the claims should be enclosed within parentheses so as to avoid confusion with other numbers or characters which may appear in the claims. See MPEP § 608.01(m).

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claims 1-4 are rejected under 35 U.S.C. 102(e) as being anticipated by Liu et al US Patent 6567273.**

Regarding claim 1, Liu et al discloses a device comprising:

- a memory part, a control device, and an I/O port, wherein an interface of the I/O port can be a USB interface, a plurality of connection terminals of the interface

are exposed, the connection terminals are implemented on the memory card, the I/O port of the memory card can communicate with an electronic device, into which the memory card is plugged, for information communication (for example, see elements 100, 120, 122, 102, Figs 1-3)

Regarding claim 2, Liu et al discloses wherein an outer appearance of the memory card can be plugged into a slot for one selected from the group consisting of an IC card, a CF card, a SIM card, a SD card, a XD picture card, a memory stick duo card, a memory stick card, a multimedia card, a MG memory stick card, a smart media card, a Microdrive card, a PCMCIA card, an ATA flash card, and a USB silicon disk (for example, see Figs 1-7, see columns 1-6) .

Regarding claim 3, Liu et al discloses wherein the I/O port can be directly connected to a computer system for information communication (for example, see Figs 1-7, see columns 1-6) .

Regarding claim 4, Liu et al discloses a device comprising:

- a control device and at least one I/O port, wherein the least one I/O port can be a USB interface, a plurality of connection terminals of the interface are exposed, the connection terminals are implemented on the mobile electronic device, the I/O port of the mobile electronic device can be connected to an electronic device for information communication (for example, see elements 100, 120, 122, 102, Figs 1-3)

**Claims 5,6,8-17,19-21,27 are rejected under 35 U.S.C. 102(e) as being anticipated by Yao US Patent 6658516**

Regarding claim 5, Yao discloses a device, comprising:

- an I/O port A, capable of connection an I/O port B of a memory card by contact a plurality of connection terminals for information communication, wherein the electronic device has a detection function to select one of multiple different communication protocols, which includes USB communication protocol, for connecting to the I/O port A on a memory card with USB communication protocol and information communication (for example, see Figs 1-6). Moreover, it has been held that the recitation that an element is "capable of" performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. In re Hutchison 69 USPQ 138

Regarding claim 6, Yao discloses wherein the electronic device further includes a detection function to select proper one of at least one of the different communication protocols, which includes USB communication protocol, for connecting to the I/O port A on one memory card of various memory cards in different communication protocols and information communication (for example, see Figs 1-6, see columns 1-6).

Regarding claim 8, Yao discloses a device comprising:

- a memory part for storing information; a control device, having at least two USB interface, used to control information communication wherein the control device can optionally be integrated into the memory part ; and a dual connector, having

at least two connection sides for connecting the at least two USB interfaces, wherein the memory card uses a USB interface to connect an electronic device for information communication, another USB connection side of the memory card connects an electronic device, into which the memory card is mounted, for information communication (for example, see Figs 1-6, see columns 1-6).

Regarding claim 9, Yao discloses wherein an outer appearance of the memory card can be plugged into a slot for one selected from the group consisting of an IC card, a SIM card, a CF card, a SD card, a XD picture card, a memory stick duo card, a memory stick card, a multimedia card, a MG memory stick card, a smart media card, a Microdrive card, a PCMCIA card, and a USB silicon disk (for example, see Figs 1-6, see columns 1-6).

Regarding claim 10, Yao discloses a device comprising:

- a memory part for storing information a control device, having only one USB interface, used to control information communication, wherein the control device can optionally be integrated into the memory part; and a dual connector, having at least two connection sides for connecting the USB interface, wherein the memory card uses a USB interface to connect an electronic device for information communication, another USB connection side of the memory card connects an electronic device, into which the memory card is mounted, for information communication (for example, see Figs 1-6, see columns 1-6).

Regarding claim 11, Yao discloses wherein an outer appearance of the memory card can be plugged into a slot for one selected from the group consisting of an

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IC card, a CF card, a SIM card, a SD card, a XD picture card, a memory stick duo card, a memory stick card, a multimedia card, a MG memory stick card, a smart media card, a Microdrive card, a PCMCIA card, and a USB silicon disk (for example, see Figs 1-6, see columns 1-6).

Regarding claim 12, Yao discloses a device comprising :

- an I/O port A, capable of connecting to an I/O port B of a slot of a memory card for then connecting to an electronic device, wherein the memory card includes one selected from one of the group consisting of an IC card, a CF card, a SD card, a XD picture card, a memory stick duo card, a memory stick card, a multimedia card, a MG memory stick card, a smart media card, a Microdrive card, and a PCMCIA card; a USB I/O port C, capable of connecting with a memory card A with USB interface to form as a memory card B; and a control unit, implemented on the memory card converter, for converting an interfacing signal of the I/O port A into a USB signal for the USB I/O port C, an outer appearance of the memory card B can be inserted/released from an electronic device with a slot for a memory card C, wherein the memory card C selected from one of the group consisting of an IC card, a CF card, a SD card, a XD picture card, a memory stick duo card, a memory stick card, a multimedia card, a MG memory stick card, a smart media card, a Microdrive card, and a PCMCIA card (for example, see Figs 1-6, see columns 1-6). ). Moreover, it has been held that the recitation that an element is "capable of" performing a function is not a

positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. In re Hutchison 69 USPQ 138

Regarding claim 13, Yao discloses a device comprising:

- a memory part and a connector with USB interface, capable of connecting a connector with of an external connection converter, so as to form a memory card B; wherein the connection converter comprises a connector with USB interface, another connector, and optionally with a control unit; and the memory card B uses the another connector to connect to a connector, which is installed on an electronic device, so as to provide access function to the memory part (for example, see Figs 1-6, see columns 1-6). ). Moreover, it has been held that the recitation that an element is "capable of" performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. In re Hutchison 69 USPQ 138

Regarding claim 14, Yao discloses , wherein an outer appearance of the memory card B can be plugged/unplugged from a slot of a memory card C, which is one selected from the group consisting of an IC card, a CF card, a SD card, a XD picture card, a memory stick duo card, a memory stick card, a multimedia card, a MG memory stick card, a smart media card, a Microdrive card, and a PCMCIA card, the memory card B takes place of the memory card C (for example, see Figs 1-6, see columns 1-6).

Regarding claim 15, Yao discloses wherein when the memory card A and the memory card B are connected, the memory card A includes a USB interface for connecting a USB connector of an external electronic device, to provide access



function to the memory part(for example, see Figs 1-6, see columns 1-6).

Regarding claim 16, Yao discloses wherein when the memory card A and the memory card B are not connected, the independent memory card A can be connected to a USB interface for connecting a USB connector of an external electronic device, to provide access function to the memory part(for example, see Figs 1-6, see columns 1-6).

Regarding claim 17, Yao discloses a device comprising:

- a memory part, used to store an information, a control device, used to control information communication, wherein the control device can optionally be integrated into the memory part, and have a first I/O port for connecting to the memory card inserted external device second I/O port for information communication ; and a plug, which can be extending out or retracting back, for connecting to a connector, and a second USB interface I/O port; wherein the memory card second USB interface I/O port, through the plug connect to an I/O port of an external electronic device for information communication(for example, see Figs 1-6, see columns 1-6).

Regarding claim 19, Yao discloses a device comprising:

- an I/O port A, capable of connecting to an I/O port B of a memory card and a plurality of connection terminals on the I/O port for information communication, wherein The electronic device has a detection function by a detection switch, memory card has a structure member to trigger the detection switch when connection, whereby one of various communication protocols in the electronic device can be selected, and a connection to th

1/0 port A of the different memory card for information communication(for example, see Figs 1-6, see columns 1-6). ). Moreover, it has been held that the recitation that an element is “capable of” performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. In re Hutchison 69 USPQ 138

Regarding claim 20, Yao discloses a device, comprising:

- an 1/0 port A, capable of connecting with an 1/0 port B of a memory card, which is inserted inside of an electronic device, and a plurality of connection terminals on the 1/0 port for information communication, wherein the electronic device has a detection connecting terminal having a detection function, for detecting an electronic signal on the connection terminal of the memory card, so as to select one of various different communication protocols, which includes a USB communication protocol, and have information communication with a memory card having the USB interface and being plugged into the 1/0 port A, wherein when connected, one terminal on the memory card with the USB interface is contacting with the detection terminals of the electronic device, wherein optionally the one connection terminal of the memory card can be one terminal in the 1/0 port B(for example, see Figs 1-6, see columns 1-6). ). Moreover, it has been held that the recitation that an element is “capable of” performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. In re Hutchison 69 USPQ 138

Regarding claim 21, Yao discloses wherein the electronic signal comprises one selected from the group consisting of a voltage level detection, a electric

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conduction detection, a impedance detection, and a predetermined specific signal detection(for example, see Figs 1-6, see columns 1-6).

Regarding claim 27, Yao discloses a device comprising:

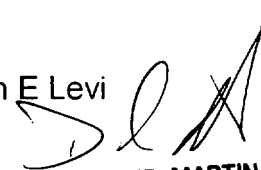
- an 1/0 port A, capable of connecting to an 1/0 port B of a slot of a memory card for then connecting to an electronic device; and a USB 1/0 port C, capable of connecting with a memory card A with USB interface to form as a memory card B; and a control unit, a USB Host, implemented on the memory card converter, for converting an interfacing signal of the 1/0 port A into a USB signal for the USB 1/0 port C, can optionally limit port C only ca connect to a memory card with USB interface(for example, see Figs 1-6, see columns 1-6). ). Moreover, it has been held that the recitation that en element is "capable of" performing a function is not a positive limitation but only requires the ability to so perform It does not constitute a limitation in any patentable sense. In re Hutchison 69 USPQ 138

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dameon E Levi whose telephone number is (703) 305-0426. The examiner can normally be reached on Mon.-Fri. (9:00 - 5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David S Martin can be reached on (703) 308-3121. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-7724.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0058.

Dameon E Levi

  
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